

## REMARKS

### I. Introduction

Claims **42-43**, **47-48**, and **51-61** are currently pending in the present application. Claims **42-43** are independent. All pending claims stand rejected. In particular:

(A) claims **47-48** and **51-61** stand rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph as being allegedly indefinite;

(B) claims **42-43**, **47**, **51**, and **54** stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 5,971,271 (hereinafter “Wynn”);

(C) claims **42-43**, **47-48**, and **51-61** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,139,431 (hereinafter “Walker I”) in view of Wynn;

(D) claim **48** stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Wynn in view of International Patent Application Publication No. WO 96/00950 (hereinafter “Walker II”); and

(E) claims **52-53** and **55-61** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Wynn in view of U.S. Patent No. 6,012,983 (hereinafter “Walker III”).

Upon entry of this amendment, which is respectfully requested, claims **47-48** and **51-61** will be amended *solely* to correct the antecedent basis issue identified by the Examiner (*e.g.*, to convert dependent claims **47-48** and **51-61** to the appropriate statutory class to match their respective parent claims; and not for *any* reason related to any reference of record). No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

### II. The Examiner’s Rejections

#### A. §112, 2<sup>nd</sup> Paragraph Rejections

Claims **47-48** and **51-61** stand rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph as being allegedly indefinite. Applicants thank the Examiner for bringing this antecedent basis issue to

Applicants' attention. Applicants amended each of claims **47-48** and **51-61** herein to correct the identified defect.

Accordingly, Applicants respectfully request that this §112, 2<sup>nd</sup> paragraph ground for rejection of claims **47-48** and **51-61** be **withdrawn**.

**B. 35 U.S.C. §102(b) Rejections – Wynn**

Claims **42-43**, **47**, **51**, and **54** stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Wynn. Applicants respectfully traverse this ground for rejection as follows.

**1. The reference fails to teach or suggest: *enabl[ing] communication between the player and the individual via the portable communication device***

Applicants respectfully assert that Wynn fails to teach or suggest limitations of claims **42-43**, **47**, **51**, and **54**. For example, Wynn fails to teach or suggest *enabl[ing] communication between the player and the individual via the portable communication device*.

The Examiner cites the Abstract of Wynn, as well as Col. 2, line 10 to Col. 3, line 29 of Wynn, Col. 5, line 7 to Col. 6, line 45 of Wynn, Col. 7, line 28 to Col. 9, 33 of Wynn, Col. 11, lines 1-64 of Wynn, and FIGS. 1-20A of Wynn as allegedly providing support for the contention that Wynn teaches the above-quoted limitation. Office Action, pg. 4, lines 3-4.

Applicants respectfully note that after a careful review of the cited sections of Wynn (as well as the remainder of Wynn), no teaching or suggestion of the above-quoted limitation could be identified. Nowhere, for example, does Wynn describe a customer utilizing a “portable communication device”. Indeed, the tethered handset described in Wynn is explicitly disclosed as providing a specific benefit – keeping the customer at the gaming device (*e.g.*, so they can perform substantially uninterrupted gambling; *e.g.*, Wynn, Col. 2, lines 43-44). Thus, not only does Wynn *not* disclose use of a portable communication device, but Wynn actually and explicitly teaches away from allowing the customer to utilize a device that would permit the customer to leave the gaming device (*e.g.*, a portable communication device as claimed).

Accordingly, at least because Wynn fails to teach or suggest *enabl[ing] communication between the player and the individual via the portable communication device*, Wynn fails to anticipate claims **42-43, 47, 51, and 54**.

Applicants therefore respectfully request that this §102(b) ground for rejection of claims **42-43, 47, 51, and 54** be **withdrawn**.

**C. 35 U.S.C. §103(a) Rejections – Walker I, Wynn**

Claims **42-43, 47-48, and 51-61** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker I in view of Wynn. Applicants traverse this ground for rejection as follows.

**1. No *Prima Facie* Case of Obviousness**

The Examiner has failed to show how every element of the claims is taught or suggested by the cited references and the Examiner has entirely failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth a valid reason that would have led one of ordinary skill in the art to combine the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

**2. The Examiner has provided no evidence that the references teach or suggest: *enabl[ing] communication between the player and the individual via the portable communication device***

Applicants respectfully assert that the Examiner has **failed to provide any evidence** that Walker I and Wynn, alone or in combination, teach or suggest limitations of claims **42-43, 47-48, and 51-61**. For example, the Examiner has provide no evidence that Walker I and Wynn teach or suggest *enabl[ing] communication between the player and the individual via the portable communication device*.

The Examiner cites Col. 2, lines 29-67 of Walker I, Col. 3, lines 28-42 of Walker I, and FIGS. 8a-9 of Walker I as allegedly providing support for the contention that Walker I teaches the above-quoted limitation. Office Action, pg. 5, lines 13-14. The Examiner also cites “49-11” of Walker I. Applicants respectfully submit that “49-11” is such a vague and ambiguous reference that Applicants lack the information necessary to formulate a response thereto. Accordingly, Applicants respectfully request that the Examiner clarify the intended citation.

Applicants further respectfully note that while the Examiner cites FIGS. 8a-9 of Walker I, Walker I only has Figures numbered through FIG. 7 (e.g., Walker I does not have FIGS. 8a-9 as cited). Accordingly, the Examiner’s rejection lacks such specificity that Applicants are unable to formulate a response thereto. Clarification so that Applicants may appropriately respond to this ground for rejection is, again, respectfully requested.

Applicants also respectfully note that the remaining portions of Walker I cited by the Examiner do not appear to provide evidence that Walker I teaches utilization of a “portable communication device” as claimed. While this is not an allegation that Walker I lacks such a teaching, it is determinative of the fact that the Examiner has failed to provide evidence to support establishment of a *prima facie* case for obviousness. Clarification as to exactly how and where the Examiner believes that Walker I contemplates such a limitation and provides written description thereof is accordingly and respectfully requested.

As described in Section II.B.1 herein, the Examiner has failed to point to any teaching or suggestion in Wynn that is descriptive of a “portable communication device” as claimed. Further as described in Section II.B.1, Wynn actually teaches away from the communication device being “portable”. Thus, Wynn simply fails to make up for the Examiner’s deficiency in providing evidence supporting the contention that Walker I teaches or suggests such a limitation.

Accordingly, at least because the Examiner has provided no evidence that Walker I and Wynn teach or suggest *enabl[ing] communication between the player and the individual via the portable communication device*, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **42-43**, **47-48**, and **51-61**.

At least for these reasons, Applicants respectfully request that this §103(a) ground for rejection of claims **42-43**, **47-48**, and **51-61** be **withdrawn**.

### **3. No Reason to Combine is Evident**

Even if the cited references taught or suggested each limitation of claims **42-43**, **47-48**, and **51-61** (of which Applicants maintain the Examiner has not set forth a *prima facie* case), the Examiner has failed to establish a *prima facie* case for obviousness for any of claims **42-43**, **47-48**, and **51-61**, at least because the Examiner has provided no valid argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine the cited references to read on the pending claims.

Accordingly, at least because the Examiner has (i) failed to show how every limitation of claims **42-43**, **47-48**, and **51-61** is taught or suggested, (ii) failed to provide a proper reason to combine the cited references, and (iii) failed to support any reason to combine by evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **42-43**, **47-48**, and **51-61**.

Applicants therefore respectfully request that these §103(a) rejections of claims **42-43**, **47-48**, and **51-61** be **withdrawn**.

### **4. No Factual Inquiries Resolved**

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved any of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine Walker I and Wynn to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **42-43**, **47-48**, and **51-61** should therefore be **withdrawn**.

**D. 35 U.S.C. §103(a) Rejections – Wynn, Walker II**

Claim **48** stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Wynn in view of Walker II. Applicants respectfully submit that claim **48** is patentable at least for depending upon a patentable base claim (claim **43**) and for the reasons described herein with respect thereto.

Applicants therefore respectfully request that this §103(a) rejection of claim **48** be **withdrawn**.

**E. 35 U.S.C. §103(a) Rejections – Wynn, Walker III**

Claims **52-53** and **55-61** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Wynn in view of Walker III. Applicants respectfully submit that claims **52-53** and **55-61** are patentable at least for depending upon a patentable base claim (claim **42**) and for the reasons described herein with respect thereto.

Applicants therefore respectfully request that this §103(a) ground for rejection of claims **52-53** and **55-61** be **withdrawn**.

### III. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Office Action does not imply agreement with those comments.

If there remain any questions regarding the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number (203) 438-6867 or via e-mail at [cfincham@finchamdowns.com](mailto:cfincham@finchamdowns.com), upon the Examiner's convenience.

### IV. Fees and Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month extension** of time and authorize the charge of **\$1,110.00** to Applicants' Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Applicants' Deposit Account No. 50-0271.

Furthermore, should any other extension of time be required or any other fee be due, please grant any extension of time which may be required to make this Response timely, and please charge any required fee to Applicants' Deposit Account No. 50-0271.

Respectfully submitted,

October 1, 2009  
Date

/Carson C.K. Fincham, Reg.#54096/  
Carson C.K. Fincham  
*Attorney for Applicants*  
Registration No. 54,096  
[cfincham@finchamdowns.com](mailto:cfincham@finchamdowns.com)  
203-438-6867 /voice  
203-461-7300 /fax